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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/563,317

07/03/2006

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EXAMINER

JARRETT, RYAN A

ART UNIT

PAPER NUMBER

2121

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/563,317	<b>Applicant(s)</b> KAMIYA ET AL.	
	<b>Examiner</b> RYAN A. JARRETT	<b>Art Unit</b> 2121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10-19 is/are pending in the application.
- 4a) Of the above claim(s) 13, 15 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-12, 14 and 16-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Response to Arguments***

Applicant's arguments, see page 18, filed 07/16/08, with respect to the specification have been fully considered and are persuasive. The specification objections have been withdrawn.

Applicant's arguments with respect to claims 10-12, 14, and 16-18 have been considered but are generally moot in view of the new ground(s) of rejection. It is noted however that Applicant's amendment has overcome the previous rejection under 35 U.S.C. 112 2<sup>nd</sup> paragraph, since the body of independent claims 10, 14, and 16 at least reflects the respective preambles. It is also noted that the rejection of claims 16-18 under 35 U.S.C. 101 (for being directed to functional descriptive material per se) has been withdrawn in light of Applicant's amendment. The rejection of claims 10-12, 14, and 16-18 under 35 U.S.C. 101 (tangibility requirement) has also been withdrawn since the claims now recite creating and outputting a program for controlling a numerical control unit, although it unclear what said creating and outputting is actually based on as discussed below.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10-12, 14, and 16-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant is respectfully requested to point out where the amended features are contained in the specification, since Examiner is having trouble finding support for such features.

For example, Examiner cannot find explicit support in the original disclosure for a “non-turning area” as recited in claims 10-12, 14, and 16-18. It is understood that the spec discloses drilling and/or milling operations, etc., which may or may not correspond to Applicant’s claimed “non-turning area”. However, Applicant's claims should remain within the bounds of the original specification and should not be broader than the original spec.

Also, Examiner cannot find support for the limitation, “if the determined process-dividing position on the inner diameter machining side or the process-dividing position on the outer machining side is within the non-turning area”, then “determining the non-turning area as the second process region in such a manner that the non-turning machining area belongs to the second process region”, as recited in independent claims 10, 14, and 16.

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Also, Examiner cannot find support the two “determining” steps recited in the “first process” of claim 10 (and the similar limitation contains in claims 14 and 16).

Claims 10-12, 14, and 16-18 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a “non-turning area” such as a drilling or milling area, does not reasonably provide enablement for all the other conceivable non-turning areas which are not taught in the original disclosure. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims. For example, a non-turning area could be a laser machined area, or an electrical discharge machined area. But such non-turning areas are not supported or enabled by the specification and one of ordinary skill in the art would not know how to make or use the invention with respect to such features in the context of the claimed invention.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10-12, 14, and 16-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 10, 14, and 16 each recite a conditional statement, “if the determined process-dividing position on the inner diameter machining side or the process-dividing position on the outer machining side is within the non-turning area”, then “determining the non-turning area as the second process region in such a manner that the non-turning machining area belongs to the second process region”.

The alternative result to the above condition not being true is not explicitly recited in the claim. Although not explicitly recited, it logically follows (it is logically implied) from the above recitation that if the determined process-dividing position on the inner diameter machining side or the process-dividing position on the outer machining side is *not* within the non-turning area, then determining the non-turning area as the *first* process region in such a manner that the non-turning machining area belongs to the *first* process region (emphasis added). However, such an alternative result does not make sense or appear possible in the context of the claims (using claim 10 as an example) since claim 10 previously recites (in lines 2-4) that the first process region is machined before the second process region, and previously recites (in lines 8-10) that the turning area is machined before the non-turning area. So, according to these previous recitations, the turning area *must* belong to the first process region, and the non-turning area *must* belong to the second process region. And thus the above alternative result to the condition not

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being true (the non-turning machining area belongs to the *first* process region), though seemingly implied by the above recitation, would not really be possible when examining the context of the claim as a whole.

The only other possible alternative result to the above condition not being true would be, if the determined process-dividing position on the inner diameter machining side or the process-dividing position on the outer machining side is *not* within the non-turning area, then determining the non-turning area as the *second* process region in such a manner that the non-turning machining area belongs to the *second* process region (emphasis added). This particular alternative result would at least make sense and be possible in the context the previous recitations (in lines 2-4 and 8-10) of claim 10 noted above, since according to these previous recitations, the non-turning area *must* belong to the second process region. However, this other possible alternative result presents problems of its own, since, if the non-turning area belongs to the second process region regardless of where the process-dividing position resides (i.e., in turning area or non-turning area), then is it unclear why the last “determining” step of claim 10 is even necessary. In other words, it is unclear why it is even necessary to determine which process region the non-turning machining area belongs to since it *always* belongs to the second process region under this other possible alternative result to the claimed condition not being true.

So, to summarize, it is unclear what the alternative result to the above condition not being true is, and how such an alternative result can be reconciled in light of the discussion above. Applicant is respectfully requested to clarify. A good starting point would be to actually recite what the alternative result to the claimed condition not being true is.

On a related note to the above discussion, claim 10 recites “the determining in...the second process” in the last line. There is insufficient antecedent basis for this limitation in the claim, since “the determining in...the second process” only occurs if the recited condition is true. There is no alternatively recited “determining” occurring if the recited condition is not true. Thus, it is unclear what the full extent of the “the determining in...the second process” recited in the last line of claim 10 really refers to. Claims 14 and 16 contain similar deficiencies. Applicant is advised to actually recite what the alternative result to the claimed condition not being true is in order to overcome this unclear antecedent basis issue.

Claim 10 recites the limitation “the machining” in line 3. There is insufficient antecedent basis for this limitation in the claim, since the previously recited “machining” in line 2 is a different type of machining than the machining recited in line 3 (i.e., one is turning and one is non-turning). Claims 14 and 16 contain the same deficiency.

Claim 10 recites the limitation “the whole machining area” in line 8. There is insufficient antecedent basis for this limitation in the claim. It is unclear if this is the exact same “machining area” recited in line 1, or if it is a larger subset of the “machining area” recited in line 1.

Claim 11 recites the limitation “the calculating of the first process” in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claims 12, 17, and 18 depend from the above claims and incorporate the same deficiencies.

It is noted that, in light of the above rejections, the claims have not been rejected on the basis of prior art since where there is a great deal of confusion and uncertainty as to the proper interpretation of the limitations of a claim, it would not be proper to reject such a claim on the



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basis of prior art. As stated in *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962), a rejection under 35 U.S.C. 103 should not be based on considerable speculation about the meaning of terms employed in a claim or assumptions that must be made as to the scope of the claims.

***Election/Restrictions***

Applicant's election with traverse of Group I, which includes claims 10-12, 14, and 16-18 in the reply filed on 07/16/08 is acknowledged. The traversal is on the ground(s) that there would be no serious burden since examiner allegedly already examined claims 10-19. This is not found persuasive because examiner only examined these claims with respect to 35 U.S.C. 101 and 112 issues. Examiner was unable to examine the claims on the merits as previously noted.

The requirement is still deemed proper and is therefore made FINAL.

Claims 13, 15, and 19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 07/16/08.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan A. Jarrett whose telephone number is (571) 272-3742. The examiner can normally be reached on 10:00-6:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on (571) 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ryan A. Jarrett/  
Primary Examiner, Art Unit 2121

08/20/08